

Remarks

Claims 1-10, 12-21, 24, 27, 32, 34-36, and 38-42 are pending upon entry of the foregoing amendments. The independent claims are claims 1, 12, and 34.

Terminal Disclaimers and Information Disclosure Statement

Applicants enclose two Terminal Disclaimers. These disclaimers are submitted to obviate a potential non-statutory double patenting rejection over claims pending in allowed Application No. 11/259,301 and allowed Application No. 10/641,507.

A Supplemental Information Disclosure Statement is submitted herewith so that the Examiner can consider co-pending applications that are commonly owned with the present application and that have claims which include the electrothermal ablation mechanism of reservoir opening.

Amendments to the Claims

Claims 1 and 12 have been amended to moot the Examiner's misinterpretation of the term "electrothermal ablation" in Applicants' claims. Support for the amendment is found, for example, at page 15, lines 3-6 and 14-20:

The reservoir cap is operably (i.e. **electrically**) **connected** to an electrical **input lead** and to an electrical **output lead**, to facilitate **flow of an electric current through the reservoir cap**. When an effective amount of an **electrical current is applied through the leads and reservoir cap**, the temperature of the reservoir cap is locally increased due to resistive heating, and the heat generated within the reservoir cap increases the temperature sufficiently to cause the reservoir cap to be electrothermally ablated (i.e., ruptured).

(*emphasis added*).

Rejections Under 35 U.S.C. § 103

Claims 1, 12, 17-19, 24, 27, 32, 34 35, and 38-42 are rejected under 35 U.S.C. § 103(a) over Santini Jr. et al. (PCT WO 01/12157) in view of Cheikh (U.S. Patent No. 5,660,846).

Claims 2-10 and 13-16 are rejected over Santini and Cheikh further in view of Rubin et al. (“The Potential of Parathyroid Hormone...,” *Int. J. Fertil.* 47(3):103-15 (2002). Claims 20-21 are rejected over Santini and Cheikh in view of Hageman (U.S. Patent No. 6,011,011). The rejections are respectfully traversed.

The rejections are premised on the Examiner’s misunderstanding of the technology used to disintegrate the reservoir cap to open the reservoir of Applicants’ device. Applicants’ claims specify methods and structures for electrothermal ablation of electrically conductive reservoir caps. Santini does not disclose or suggest electrothermal ablation.

The portions of Santini cited by the Examiner describe thermal means for reservoir openings, but these means require a reservoir cap and a distinct, separate resistor. In Santini, the electric current flows through a separate resistive heater. Electric current does not flow through the reservoir cap. Accordingly, there is no electrical input lead or electrical output lead electrically connected to the reservoir cap. In contrast, Applicants in the instant case do not claim a separate resistive heater; in fact, they have eliminated the need for a separate resistive heating element.

The Examiner cites Figure 5 and page 39 of Santini. Yet, these do not show or describe electrothermal ablation. For example, they do not show, describe, or suggest input and output leads electrically connected to the reservoir cap. Rather, Santini teaches:

Here, three of the reservoirs are provided with resistors 140a positioned near the reservoir caps 120a, while the other three reservoirs are provided with resistors 140b positioned on top of reservoir caps 120b.

(Page 39, Lines 20-23, emphasis added).

Santini teaches that a resistive heating element is used to heat a distinct reservoir cap. The arrangement of “nearby” or “on top of” means that Santini teaches using a resistance heating element that is a *distinct* structure from the reservoir cap and that heat must flow *from* resistor 140 *to* the reservoir cap 120. In contrast, Applicants’ claimed methods and devices require a reservoir cap that *itself* is heated by internally generated heat caused by passage of an electrical current therethrough. The heating is localized within the reservoir cap. Santini does not teach internally generated heating and thus does not teach electrothermal ablation.

The Examiner also cites Santini at page 2, lines 15-20, page 10, lines 14-23, page 13, and Figure 9C. These portions also fail to describe electrothermal ablation. Instead, these portions describe passing electric current through separate resistors, not passing electric current the reservoir cap itself.

Page 2, lines 15-16, of Santini discloses that

...the device includes a resistor integrated **into the reservoir** or **mounted near or on the reservoir cap**,..

(emphasis added)

This means that a distinct element, the resistor, can be located inside the reservoir, or alternatively, the resistor can be located on top of or nearby the reservoir cap. It does not teach or suggest that the reservoir is the resistive heating element, as Applicants' claims require.

Furthermore, Page 2, lines 16-20, of Santini discloses that

upon application of an electric current through the resistor...the contents of the reservoir...thermally expand, vaporize, phase change, or undergo a thermally driven reaction, **such that the reservoir cap ruptures due to mechanical stress**.
(emphasis added)

This is a description of heating the reservoir contents and causing a pressure build up inside the reservoir to burst the reservoir cap from within. It is not a description of electric current flowing through the reservoir cap. It is not a description of input leads and output leads electrically connected to a reservoir cap. It thus is not a description of electrothermal ablation.

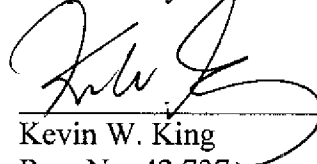
The Examiner's reliance upon Page 10, Lines 14-23, of Santini also is misplaced. This too is a description of a thermal mechanism of rupture that is not electrothermal ablation because there is no electrical current flowing through the reservoir cap. This paragraph in Santini describes rupturing as illustrated in FIGS. 12a-c. It is clear from these drawings that the resistive heaters are located outside of reservoir in a location physically spaced apart from the reservoir caps. There are no electrical input or output leads connected to the reservoir cap in FIGS. 12a-c.

In sum, nothing in Santini describes or suggests means for electrothermal ablation. Cheikh, Rubin, and Hageman, alone or in combination with one another and Santini, fail to

remedy this deficiency. Accordingly, the cited prior art fails to provide any teaching that reasonably could be construed to set forth a *prima facie* case of obviousness. The rejections should be withdrawn.

The undersigned respectfully invites the Examiner to contact him by telephone (404.853.8068) if any issues can be resolved by conference or examiner's amendment to facilitate prosecution of applicants' claims.

Respectfully submitted,



Kevin W. King
Reg. No. 42,737

Date: October 9, 2008

SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street, NE
Atlanta, Georgia 30309-3996
(404) 853-8068
(404) 853-8806 (fax)